

## REMARKS

This is intended as a full and complete response to the Office Action dated December 9, 2008, having a shortened statutory period for response set to expire on February 9, 2009. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1-18, 20-22 and 24-30 are pending in the application and remain pending following entry of this response. Claim 1 has been amended. Applicants submit that the amendments do not introduce new matter.

Further, Applicants are not conceding in this application that the amended claim is not patentable over the art cited by the Examiner, as the present claim amendment are only for facilitating expeditious prosecution of the claimed subject matter. Applicants respectfully reserve the right to pursue these (pre-amended or canceled claims) and other claims in one or more continuations and/or divisional patent applications.

### Claim Rejections - 35 U.S.C. § 101

The Examiner's Answer states a new ground of rejection under 35 U.S.C. § 101. Claims 1-12 are rejected under 35 U.S.C. § 101 because the claimed invention is directed to non-statutory subject matter.

Applicants have amended claim 1 to recite "configuring one or more computer processors with a price-guarantee batch program to compare the item purchase price to a comparison price comprising at least one of an item current price and an item match price". Accordingly, the claim recites a specific processor configured by a specific program. Because the claim is directed to statutory subject matter Applicants request that the rejection be withdrawn.

### Claim Rejections - 35 U.S.C. § 103

Claims 1-11 and 13-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *McClung* (U.S. Pub No. 2004/0143502).

Applicants respectfully traverse this rejection.

The Examiner bears the initial burden of establishing a *prima facie* case of obviousness. See MPEP § 2141. Establishing a *prima facie* case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the Graham factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art.

Respectfully, Applicants submit that the Examiner has not properly characterized the teachings of the references and/or the claims at issue. Accordingly, a *prima facie* case of obviousness has not been established.

*McClung* is directed to a computer-implemented method for guaranteeing a consumer a best price on an item or service purchased from a vendor for a predetermined time period following the transaction. (Abstract, *McClung*). The method disclosed by *McClung* monitors prices after a purchase by a consumer and if a lower price is found at a later time, gives a consumer a refund, a credit, and/or a coupon or certificate for use equaling the difference in sale prices. (See, e.g., ¶[0007], ¶[0150], Figures 5 and 11, *McClung*).

Regarding claims 1-7, 11, 13-18, the Examiner argues that

"*McClung* teaches a host computer system as tracking a transaction by the item and purchase price, receiving and storing price matching data including an item match price, comparing the purchase price to a comparison price (item match price) periodically (over different time periods), and administering a credit for the price differential to the customer if the comparison price is lower than the purchase price (Paragraph 0007). The system would inherently have to obtain an account number (customer identification number) in order to credit the customer's account. *McClung* also teaches the credit card account as being an

account with the vendor (Paragraph 0008, Sentence 3 and Paragraph 0131, Sentence 1). A step of determining whether a user is a member of the system (signed up through a vendor) is inherent when a purchase takes place. McClung, however, does not specify what action takes place should a user not have an account with the system. It would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up."

Applicants respectfully submit that *McClung* does not teach or suggest all the claim limitations. For example, *McClung* does not teach or suggest determining whether the item is purchased using a store credit card account for the store from which the item is purchased. The Examiner argues that "[a] step of determining whether a user is a member of the system (signed up through a vendor) is inherent when a purchase takes place." Applicants respectfully submit that such determining step is not at all inherent when a purchase takes place. For example, a customer who has a store credit card or account (i.e., a "member of the system") may make a purchase using another credit card or cash without ever disclosing that he has a store credit card. The purchase would take place without determining whether the customer is a "member of the system."

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

As such, the step of determining whether a user is a member of the system is not inherent and is not taught or suggested by *McClung*. Moreover, as recited in the claims,

the determination is with respect to an item purchased as related to a store credit card account, not with respect to whether the purchaser is a "member of the system." No such determination is taught or suggested by *McClung*.

As another example, *McClung* does not teach or suggest that different actions are performed based upon the determination of whether the item is purchased using a store credit card account for the store from which the item is purchased. As recited in the claims, price guarantee credits are given only for items purchased using a store credit card account, whereas, for items not purchased using a store credit card account, a notification is given to the customer about the potential credits obtainable if the store credit card had been used.

As yet another example, *McClung* does not teach or suggest notifying the customer of potential credits obtainable if the store credit card had been used, if the item is not purchased using the store credit card account. The Examiner argues that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to an explanation of the types of savings (such as price matching or price guarantees) that could be incurred through signing up. This would provide a greater chance of that non-member signing up." Applicants respectfully submit that the Examiner has mischaracterized the teachings of the cited reference and has applied improper hindsight in stating that such feature would have been obvious. *McClung* does not teach or suggest any different treatment between customers who used store credit cards to make a purchase and those who did not, since *McClung* discloses providing price guarantees to customer without distinguishing treatments between customers who have store credit cards and those who do not. Therefore, there is no teaching or suggestion by *McClung* for notifying customers of the potential credits.

The other pending independent claims are rejected pursuant to the same rationale as was claim 1 (Examiner's Final Action, p. 6, paragraph 10) and, accordingly, are believed to be allowable for the same reasons given above. Since Applicants believe that the independent claims are allowable, the dependents are therefore also believed to be allowable.

Claims 11, 12, 29 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *McClung* in view of *Walker* (U.S. Pub No. 2001/0042785).

*McClung* is discussed above. *Walker* discloses a financial tender system which allows a transferor to transfer credit or make payment to a transferee by debiting the credit card of the transferor and crediting the credit card of the transferee. (Abstract, *Walker*).

Regarding claims 11, 12, 29 and 30, the Examiner argues that

"*McClung* teaches crediting an account with a vendor to implement a guaranteed pricing promotion. *McClung* doesn't teach the transferring of balances between different credit accounts. *Walker* teaches that it is well-known to transfer debt balances between accounts to take advantage of different account features (Paragraph 0011, Sentence 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to transfer a credit balance from one account to another in order to take advantage of retailer guaranteed pricing. It would also have been obvious to one having ordinary skill in the art at the time the invention was made to notify a non-member at a time of purchase as to potential credits that could be incurred through transferring a balance. This would provide a greater chance of that non-member transferring the balance."

Applicants respectfully submit that *McClung*, as discussed in the above examples, fails to teach or suggest all of the claim limitations with respect to the independent claims. Moreover, the cited references, *McClung* and *Walker*, either alone or in combination, fail to teach or suggest notifying the customer of potential credits if the item is not purchased using the store credit card account. Furthermore, the cited references, either alone or in combination, fail to teach or suggest determining whether the customer has transferred a balance from another credit card account to the store credit card account, wherein the amount is credited to the store credit card account of

the customer if the customer has transferred a balance from another credit card account to the store credit card account. Applicants respectfully submit that the Examiner again has applied improper hindsight in stating that such feature would be obvious. The cited references simply do not provide any teaching or suggestion for any incentive for transferring balances.

Therefore, the claims are believed to be allowable, and allowance of the claims is respectfully requested.

Conclusion

Having addressed all issues set out in the Examiner's Answer, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted, and  
**S-signed pursuant to 37 CFR 1.4,**

/Gero G. McClellan, Reg. No. 44,227/

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Gero G. McClellan  
Registration No. 44,227  
PATTERSON & SHERIDAN, L.L.P.  
3040 Post Oak Blvd. Suite 1500  
Houston, TX 77056  
Telephone: (713) 623-4844  
Facsimile: (713) 623-4846  
Attorney for Applicant(s)